

REMARKS

Applicants thank the Examiner for the thorough examination of the application. No new matter is believed to be added to the application by this amendment.

Entry of Reply

Entry of this Reply under 37 C.F.R. §1.116 is respectfully requested because it places the application into allowance. Alternately, entry of this Reply is requested because it reduces issues for appeal. Also, this Reply addresses a matter of form (Drawing Correction) in the Office Action.

Status of the Claims

Claims 1-20 are pending in the present application. Claims 1, 4, 8, 13 and 15 are independent claims. The claim amendments find support at pages 14 and 15 of the specification.

Objection to the Drawings

The Examiner objects to the proposed correction of Fig. 9B as containing an improper removal of the legend "Conventional Art." The proposed removal of this legend constitutes a correction of a typographical error that occurred when the application was transliterated into English.

However, in order to expedite prosecution on the merits, Fig. 9B has been amended to bear the legend "Conventional Art."

Rejections Based on Yamauchi

Claims 1 and 3 remain rejected under 35 U.S.C. §102(e) as being anticipated by Yamauchi (U.S. Patent 6,047,103). Claim 2 remains rejected under 35 U.S.C. §103(a) as being obvious over the combination of Yamauchi and Sandifer (U.S. Patent 5,778,381). Applicants traverse.

The present invention pertains to a novel file management method that determines if a file name and/or directory change will render impossible the reproduction of real-time data files in a disk-recording medium such as a DVD. The present invention finds a typical embodiment in instant claim 1, which sets forth:

1. A file managing method in reproducing a rewritable disk, comprising the steps of:
 - (a) checking the file names, directories, or names and directories of files written in the rewritable disk;
 - (b) providing a message indicating that reproduction is impossible when the file names, directories, or names and directories are against a standard file scheme pre-specified for a disk containing real-time data; and
 - (c) conducting a correction operation, if demanded.

Distinctions of the invention over Yamauchi and Sandifer have been placed before the Examiner. Yamauchi pertains to a filtering method to decide "whether or not the data receiving device is a proper data receiving device." See

Abstract of Yamauchi. The invention, in contrast, is directed at checking a file structure with a standard file system pre-specified for a disk containing a real-time data stream, and correcting the file structure if the file structure does not conform to the standard file system. That is, the invention is directed at the inclusion of off-format data while, but Yamauchi is directed at the exclusion of tagged copyrighted material.

However, at page 5 of the Office Action, the Examiner states:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features relied upon which the applicant relies (i.e., correcting the file structure if the file structure does not conform to the standard file system) are not recited in the claim(s).

In contrast, instant claim 1 now explicitly recites a correcting operation.

As a result, Yamauchi clearly fails to anticipate or suggest the invention as embodied in claim 1. Claims dependent upon claim 1 are patentable for at least the above reasons. Further, Sandifer fails to address the inability of Yamauchi to disclose or suggest the invention. A *prima facie* case obviousness has thus not been made over the combination of Yamauchi and Sandifer.

These rejections are accordingly overcome and withdrawal thereof is respectfully requested.

Rejections Based on Yamada

Claim 4 remains rejected under 35 U.S.C. §102(e) as being anticipated by Yamada (U.S. Patent 6,490,683). Claims 5 and 6 remain rejected under 35 U.S.C. §103(a) as being obvious over the combination of Yamada and Siquin (U.S. Patent 6,425,098). Claim 7 remains rejected under 35 U.S.C. §103(a) as being obvious over the combination of Yamada, Siquin and Sandifer. Applicants traverse.

The present invention pertains to a novel file management method that determines if a file name and/or directory change will render impossible the reproduction of real-time data files in a disk-recording medium having a standard file scheme, such as a DVD. The present invention is typified by instant claim 4, which sets forth:

4. A file managing method in recording a data stream in a rewritable disk, comprising the steps of:
 - (a) checking a file name, directory, or name and directory of the file requested to be recorded in the rewritable disk;
 - (b) providing a message indicating that reproduction would fail later if recorded as requested when the file name, directory, or name and directory is against a standard file scheme pre-specified for a disk containing real-time data file; and
 - (c) conducting a correction operation, if demanded.

Distinctions of the invention over Yamada and the secondary references have been placed before the Examiner. Yamada pertains to an electronic watermark where Yamada at column 21 lines 11-12 states "an error message indicating the data is copied dishonestly or dishonestly renewed."

Yamada fails to disclose or suggest a correcting step. Yamada also fails to disclose or suggest checking a file name and/or directory for a file requested to be recorded on an optical disk, followed by sending a message that the reproduction would fail if is against a standard file scheme pre-specified for a disk containing real-time data file.

In contrast, the invention is directed at the inclusion of off-format data and can include a correcting step to facilitate the inclusion of this data.

However, in the paragraph bridging pages 5 and 6 of the Office Action, the Examiner states:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features relied upon which the applicant relies (i.e., sending a message to correct the file structure if the file structure does not conform to the standard file system) are not recited in the claim(s).

In contrast, instant claim 4 now explicitly recites a correcting operation.

Yamada, as a result, fails to anticipate or suggest independent claim 4. Claims dependent upon claim 4 are patentable for at least the above reasons.

The Examiner then turns to Siquin to allege teachings pertaining to recording or deleting received data if requested. The Examiner turns to Sandifer to allege that this reference discloses that the message gives the reason why the reproduction is impossible. However, neither Siquin nor Sandifer address the deficiencies of Yamada in suggesting a claimed

embodiment of the invention. A *prima facie* case of obviousness has thus not been made over the combination of Yamada and the secondary references.

These rejections are accordingly overcome and withdrawal thereof is respectfully requested.

Rejections Based on Bills

Claim 8 remains rejected under 35 U.S.C. §102(e) as being anticipated by Bills (U.S. Patent 6,330,571). Claims 9-11 remain rejected under 35 U.S.C. §103(a) as being obvious over Bills in view of Sinquin. Claim 12 remains rejected under U.S.C. §103(a) as being obvious over Bills in view of the Applicants' disclosure. Applicants traverse.

Amended independent claim 8 sets forth a method of checking and providing a message as follows:

8. A method conducted in a computer for managing files written in a rewritable disk, comprising the steps of:

(a) checking the file type if the file is requested to be renamed or moved;

(b) providing a message indicating that disk reproduction would be impossible after the file is renamed or moved, if the file type is one among pre-specified file types; and

(c) conducting a correction operation, if demanded.

Bills pertains to a method for datalink path protection. The Examiner typically turns to column 3, lines 10, which describes "checking the datalink indicator." The Examiner then alleges that column 10, lines 35-45 pertains to providing a message indicating that disk reproduction would be impossible

after the file is renamed or moved, if the file type is one among pre-specified file types. This passage, however, pertains to the logic of using the datalink indicator shown in Fig. 6 of Bills, and not to providing a message that disc reproduction would be impossible.

Bills also fails to disclose or suggest a correcting step.

As a result, Bills clearly fails to anticipate or suggest the invention as is set forth in claim 8. Claims dependent upon claim 8 are patentable for at least the above reasons.

Sinquin fails to address the deficiencies of Bills. The Examiner discusses the relationship of Sinquin with the recording standard in the paragraph bridging pages 8 and 9 of the Office Action, stating: "In other words, the present invention takes advantage of error-avoidance features of the recording standard *in an unexpected way.*" (emphasis added) However, doing something "in an unexpected way" is the very essence of novelty.

The Applicants' disclosure, if it could be used, also fails to address the deficiencies of Bills. However, the Applicants respectfully note that using the Applicants' disclosure to allege prior art without an admission of prior art has been held to be improper. Riverwood International Corp. v. Jones & Co., Ltd., 324 F.3d 1346, 66 USPQ2d 1331 (Fed. Cir. 2003). As a result, adding Sinquin or the Applicants' disclosure to Bills each fails to allege *prima facie* obviousness.

These rejections are accordingly overcome and withdrawal thereof is respectfully requested.

Rejections Based on Siquin

Claims 15 and 18-20 remain rejected under 35 U.S.C. §102(e) as being anticipated by Siquin. Claim 16 remains rejected under 35 U.S.C. §103(a) as being obvious over the combination of Siquin and Bills. Claim 17 remains rejected under 35 U.S.C. 103(a) as being obvious over the combination of Siquin and Yamauchi. Applicants traverse.

The present invention pertains to managing data on a rewritable disk. The invention embodied in independent claim 15 sets forth:

15. A file managing method in recording data stream in a rewritable disk, comprising the steps of:

- (a) checking whether or not a file structure formed in the rewritable disk conforms to a standard file system pre-specified for a disk containing real-time data stream;
- (b) correcting the file structure of the rewritable disk if the file structure is against the standard file system; and
- (c) writing input data stream in a data file belonging to the corrected file structure.

Siquin pertains to the prevention of disk piracy. The Examiner turns to column 3 of Siquin, which pertains to intentionally introduced errors. Siquin at column 3, lines 26-28 discloses: "using recoverable errors introduced in the original recording medium to cause more serious, unrecoverable faults to be generated in the copy."

Siquin fails to disclose or suggest "correcting the file structure of the

rewritable disk if the file structure is against the standard file system," as is set forth in claim 15. Claims dependent upon claim 15 are patentable for at least the above reasons.

Also, Sinqin teaches the introduction of errors to prevent piracy. This clearly teaches away from the invention, which is directed at correcting file structure.

Further, the Examiner acknowledges the novelty of Sinqin. The Examiner discusses the relationship of Sinqin with the recording standard in the paragraph bridging pages 8 and 9 of the Office Action, stating: "In other words, the present invention takes advantage of error-avoidance features of the recording standard *in an unexpected way*." (emphasis added). However, doing something "in an unexpected way" is the very essence of novelty.

Sinqin accordingly cannot be utilized as the basis to allege *prima facie* obviousness. The addition of the secondary references of Bills and Yamauchi fail to address the deficiencies of Sinqin.

These rejections are accordingly overcome and withdrawal thereof is respectfully requested.

Rejections based on Chen

Claim 13 remains rejected under 35 U.S.C. §103(a) as being obvious over Chen (U.S. Patent 5,960,170) in view of Bills. The Examiner adds the teachings of Sinqin to reject claim 14. Applicants traverse.

The present invention pertains to a method of managing files on a rewritable disc. Amended independent claim 13 sets forth:

13. A method conducted in a computer for managing files written in a rewritable disk, comprising the steps of:

(a) checking the types of all files under a directory if the directory is requested to be renamed;

(b) providing a message indicating that disk reproduction would be impossible after the directory is renamed, if the type of at least a file under the directory is one among pre-specified file types; and

(c) conducting a correction operation, if demanded.

Chen pertains to virus protection. The Examiner utilizes column 18, lines 5-25, which describes inspecting file headers to determine if the file is likely to contain a virus. Chen fails to disclose "checking the types of all files under a directory if the directory is requested to be renamed," as is set forth in independent claim 13. The Examiner admits to this deficiency at page 22, lines 9-10 of the Office Action.

Chen additionally fails to disclose a correcting operation, if demanded.

Further, Chen is directed at a fundamentally different object: virus detection. At page 10 of the Office Action the Examiner addresses the fundamentally different object of Chen: "Examiner agrees that Chen pertains to virus protection. Virus protection also requires file management functions to access the files to be scanned." By this, the Examiner is inferring that Chen inherently discloses or suggests checking the types of all files under a directory if the directory is requested to be renamed.

Regarding inherency, the Federal Circuit stated in In re Robertson, that "to establish inherency, extrinsic evidence must make clear that the missing descriptive matter was necessarily present in the thing described in the reference, and would be so recognized by persons with ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a set of circumstances is not sufficient." In re Robertson, 49 USPQ2d 1949 (Fed. Cir. 1999). Further, it has been held that the mere fact that a certain thing may result from a given set of circumstances is not sufficient, and occasional results are not inherent. MEHL/Biophile International v. Milgraum, 52 USPQ2d 1303 (Fed. Cir. 1999).

A person having ordinary skill would therefore have no motivation to use any of the teachings of Chen for developing a file managing method, such as is set forth in claim 13.

The Examiner then alleges that Bills discloses *inter alia* providing a message. The failure of Bills to disclose or suggest this feature has been discussed above. As a result, a person having ordinary skill would not be motivated by Chen and Bills to produce the invention as embodied in claim 13. The addition of the teachings of Siquin (the deficiencies of which have been discussed above) fails to address the deficiencies of Chen and Bills. A *prima facie* case of obviousness has thus not been made over Chen and Bills or Chen, Bills and Siquin.

These rejections are accordingly overcome and withdrawal thereof is respectfully requested.

Prior Art Cited But Not Used By The Examiner

The prior art cited but not used by the Examiner show the status of the conventional art that the invention supercedes. No additional remarks are accordingly necessary.

CONCLUSION

For the foregoing reasons and in view of the above clarifying amendments, Applicants respectfully request the Examiner to reconsider and withdraw all of the objections and rejections of record, and earnestly solicit an early issuance of a Notice of Allowance.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Registration No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASH & BIRCH, LLP

By 
Joseph A. Kolasch, #22,463

P.O. Box 747
Falls Church, VA 22032-0747
(703) 205-8000


JAK/REG:jls

Attachment: One sheet of corrected formal drawing